

REMARKS/ARGUMENTS

Claims 17, 19, 21, 22, 24-26, and 28-40 remain in this application.

Rejection Under 35 USC 112, First Paragraph

Claims 17, 19, and 21-22, 24-26, and 28-40 were rejected under 35 USC 112, first paragraph. See Pages 2-5 the Office Action. According to the Office Action, “the specification, while being enabling for treating, increasing or tightening the firmness of skin . . . does not reasonably provide enablement for relaxing or decreasing the firmness of skin.” See Page 3 of the Office Action. Applicants respectfully disagree. The term “regulating the firmness of skin” is defined on pages 2-3 of the specification, to mean “the enhancing of the firmness or elasticity of the skin, preventing the loss of firmness or elasticity of skin, or preventing or treating sagging, lax and loose skin.” The term “regulating wrinkles in skin” is defined on page 3 of the specification to mean “preventing, retarding, arresting, or reversing the process of wrinkle and fine line formation in skin.” Thus, “regulating the firmness or tone of skin of a subject or regulating wrinkles in skin” is not defined by the Applicants to encompass both increasing wrinkles in the skin as argued on page 3 of the specification. Applicants, therefore, respectfully request that the above rejection under Section 35 USC 112, first paragraph, be withdrawn.

Rejection Under 35 USC 102

Claims 17, 19, and 21-22, 24-26, and 28-40 were rejected under 35 USC 102(b) as being anticipated by Japanese Patent 61291515 (the “515 Patent”). See Page 6 of the Office Action. According to the Office Action, the method of the ‘515 Patent “inherently treats the skin in a subject for regulating the firmness, tone, or texture of skin of a subject or for regulating wrinkles in skin of a subject . . . since [the ‘515 Patent] method steps are same as the instant method steps.” See Page 6 of the Office Action. Applicants respectfully disagree.

Applicants had previously amended claim 17 to recite the topical administration of the composition to the skin of said subject in need of such regulating. As stated in the previous response filed October 28, 2003, the ‘515 Patent does not disclose the topical application of such a composition to such skin. Rather, the ‘515 Patent discloses the application to

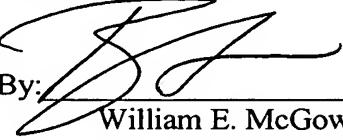
sunburned skin, to rough skin, razor rashed skin, and inflamed skin. As previously stated in the prior amendment, Section 2112.02 of the M.P.E.P. states “The discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using.” The ‘515 Patent does not teach the topical application of a composition to the skin of said subject in need of regulating its firmness or tone or regulating its wrinkles. Furthermore, as set forth in In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), “To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'” The Office Action on page 7 states that “one of ordinary skill in the art would clearly recognize that sunburn, rough skin, razor rash, and inflammation are liable to damage or affected skin firmness, tone, or cause of wrinkles.” No support, however, is put forth for this assertion (e.g., a teenager may have a sunburn, rough skin, razor rash, and inflammation but do not necessarily suffer from wrinkles, skin sallowness, or skin firmness). Thus the skin that is treated in the ‘515 Patent would not necessarily be in need be in need of regulation of firmness, tone, or wrinkles, as recited in claim 17.

In addition, independent claim 31 recites “a method of promoting a composition comprising Hedychium extract, said method comprising promoting said composition for regulating the firmness or tone of skin or regulating wrinkles in skin.” As discussed in the prior paragraph, the ‘515 Patent does not teach nor suggest the use of such a composition for regulating the firmness or tone of skin or regulating wrinkles in skin. Thus, the ‘515 Patent does not teach, nor suggest, such a method of promoting recited in claim 31 and claims 32-409 that depend from such claim.

Accordingly, Applicants respectfully request the withdrawal of the above rejection under 35 USC 102(b).

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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